

REMARKS & ARGUMENT

Claims 1-10 are under non-final rejection. With this amendment the applicant has revised & clarified claims 1, 2 & 6 and canceled claims 3-5, and 7-10.

35 USC 112 rejection has been obviated by withdrawal of claim 3.

5 Claims 1 & 6 stand rejected under 35 USC 102(b) as anticipated by Goodman et al.

10 Goodman '875 does not teach hardware solution. Goodman solution is a software solution which is not directly connected to the mouse port but indirectly simulated by software in the computer through the keyboard port. (Column 3 lines 6-12)

The applicant's solution is a firmware and hardware solution where the key pad is directly connected to the mouse port. To clarify this the applicant with this amendment has amended claim 1 to clearly enunciate that the hardware device is connected directly to the mouse port.

15 Because of these differences it is the applicant's position that Goodman's software solution under no circumstances can anticipate applicant's teaching of hardware solution where the applicant's keypad is directly connected to the mouse port of the computer and not the keyboard port. Thus claim 1 is allowable and so is claim 6 as being dependant and narrower in scope than claim 1.

20 Claim 1 & 2 also stand rejected under 35 USC 103 over Goodman '875 in view of Selig '978 but the applicant's teaching is not only not anticipated but also non-obvious over this prior art for substantially the same reasons as presented under 35 USC 102 above.

25 Neither Goodman '875 nor Selig '978 teach or even suggest how to convert their software solution into applicant's hardware solution.

The arrow keys of Goodman '875 are on the keyboard which is connected to the keyboard port.

In sharp contrast applicant's keypad is plugged directly into the mouse port of the computer and yet it satisfactorily generates the data stream of a pointing device to affect the curser motion not only in vertical and horizontal directions but also in diagonal directions by pressing two adjacent switches and wherein speed of the cursor is proportional to the duration of depression of the switches. There is absolutely no suggestion let alone teaching of the applicant's invention in the prior art as to how to emulate by firmware not only the direction but also the speed of the of the cursor movement of the conventional mouse with a keypad plugged directly into the mouse port.

The applicant's invention is breath takingly simple and even elegant. It is ironic that such a simple invention has escaped the experts for such a long time. The applicants invention is simply elegant and therefore may appear obvious in hindsight but in reality it is any thing but obvious. In retrospect the applicant's invention appears simple, but this simplicity is elegant and non-obvious and is the hallmark of most ingenious good inventions. Simplicity does not negate non-obviousness. "The subject matter as a whole" in 35 USC 103, is particularly problematic in simple inventions.

In 1908, the United States Supreme Court, in *Expanded Metal Co. v. Bradford*, 214 U.S. 366, 381, 29 S.Ct. 652, 53 L.Ed.1034, 1039 said, "The fact that the invention seems simple after it is made does not determine the question; if this were the rule, many of the most beneficial patents would be stricken down."

In 1959, Circuit Judge Medina, in a case in the Second Circuit Court of Appeals (*American Safety Table Co v/s Schreiber*, 269 F.2d 255, 263, 122 USPQ 29,36 said, " In the last analysis the burden of *Schreiber & Goldberg's* attack on the first patent for lack of invention comes down to its simplicity.

But experience in practically every field of human endeavor has demonstrated that the very simplicity of a new idea is the truest and most reliable indication of novelty and invention, when others have devoted extensive effort and exhausted their resourcefulness in a futile search for the solution of the same vexing problem.

Potts v. Creager, 1895,155 U.S. 597, 608, 15 S.Ct.194, 39 L.Ed. 275; Lyon v. Bausch & Lomb Optical Co., 2 Cir., 1955, 224 F.2d 530,534, certiorari denied 350 US 911, 76 S.Ct. 193; H C White v. Morton E. Converse & Son Co., 2 Cir., 1927, 20 F.2d 311, 313, certiorari denied, 275 U.S. 5.47, 48 S.Ct. 85, 72 L.Ed. 419.

5 In hindsight the applicant's invention appears obvious. But that is the danger of hindsight as the Supreme Court, in Calmar, Inc. v. Cook Chemical Co. (383 U.S. 1, 86 S.Ct. 684, 15 L.Ed.2d 545 (1966) mentioned the danger of "slipping into hindsight," citing the case of Monroe Auto Equipment Co. v. Heckethorn Mfg. & Sup. Co., 332 F.2d 406, 141 USPQ 549 (6th Cir.1964) said,

10 " We must view the prior art from the point in time just prior to when the patented device was made. Many things may seem obvious after they have been made and for this reason the courts should guard against slipping into use of hindsight.

We must be careful to "view the prior art without reading into that art the teachings of appellant's invention." Application of Sporck, 301 F.2d 686, 689 (CCPA).

15 Its the applicant's position that Justice Frankfurter was quite right in his dissent in Marconi Wireless Telegraph Co. v. United States, 320 U.S.1, 60, 63 S.Ct.1393, 1421, 87 L. Ed.1731, 1763 (1943)

20 " The discoveries of the science are the discoveries of the laws of nature and like nature do not go by leaps. Even Newton and Einstein, Harvey and Darwin built on the past and on their predecessors. Seldom indeed has a great discoverer or inventor wandered lonely as a cloud.

Great inventions have always been parts of an evolution; the culmination at a particular moment of an antecedent process.

25 So true is this that the history of thought records striking coincidental discoveries-showing that the new insight first declared to the world by a particular individual was "in the air" and ripe for discovery and disclosure.

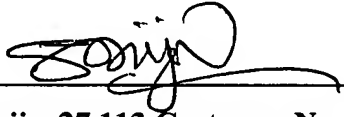
The real question is how significant a jump is the new disclosure from the old knowledge. Reconstruction by hindsight, making obvious something that was not at all obvious to superior minds until someone pointed it out, - this is too often a tempting

exercise for astute minds. The result is to remove the opportunity of obtaining what Congress has seen fit to make available."

5 In view of the foregoing arguments, it is the applicants position that applicant's claim 1 is neither anticipated by Goodman '875 nor obvious over Goodman '875. Therefore claim 1 is allowable. Since claims 2 & 6 are dependant claims of claim 1 and narrower in scope are also allowable.

10 In conclusion it is the applicant's position that claims 1, 2 & 6 have been put in a condition for allowance by the applicant with this amendment. Formal drawings are deferred pending notice of allowance which is earnestly solicited.

Respectfully Submitted



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